

### **REMARKS**

Claims 1-11 are pending in the instant application. Claims 1-11 stand rejected under 35 USC § 112, first paragraph as failing to comply with the written description requirement. Claims 1-11 stand rejected under 35 USC § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-11 stand rejected under 35 USC § 102 (b) as being anticipated by Axelsson et al. (WO 00/071166 and its US equivalent US 6,872,380). Claims 1-11 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3-6 of copending Application No. 10/526,240. The application has been amended. The specification has been amended. The claims have been amended. More specifically, the numbers included in parenthesis have been deleted from claims 1, 2, 4-7, 10 and 11 in order to overcome the claim rejections under 35 USC § 112, second paragraph. Applicants respectfully submit that none of the amendments constitute new matter in contravention of 35 U.S.C. §132. Reconsideration is respectfully requested.

#### **Claim rejections – 35 USC § 112, first paragraph**

Claims 1-11 stand rejected under 35 USC § 112, first paragraph as failing to comply with the written description requirement. This rejection is respectfully traversed.

The specification refers to suitable substrate compounds which may be used in the claimed method to be hydrogenated with para-hydrogen enriched hydrogen as those found in WO 99/24080. The Examiner states that incorporation in the specification by reference to an unpublished U.S. application, foreign application or patent is improper. Applicants note that the international publication date of WO 99/24080 is May 20, 1999 which is about three years prior to the present application's priority date (August 29, 2002). Hence the specification includes a reference to a published PCT application (with the US being a designated state) in English language. WO 99/24080 entered national phase from the PCT in the US and resulted in granted US patent number 6,574,495. Applicants have amended the specification referring for the first time to WO 99/24080 by including the term "now issued

as United States Patent No. 6,574,495 on June 03, 2003". In view of this amendment, Applicant submits that the rejection stands obviated. Reconsideration and withdrawal of the rejection are respectfully requested.

**Claim rejections – 35 USC § 112, second paragraph**

Claims 1-11 stand rejected under 35 USC § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully submits that, due to the amendments to claims 1, 2, 4-7, 10 and 11 to delete the numbers in parentheses, this rejection stands obviated. Reconsideration and withdrawal of the rejection are respectfully requested.

**Claim rejection – 35 USC § 102**

Claims 1-11 stand rejected under 35 USC § 102 (b) as being anticipated by Axelsson et al. (WO 00/071166 and its US equivalent US 6,872,380). This rejection is respectfully traversed.

First, Axelsson et al. is discussed in the present application, page 2, line 22 to page 3, line 7. In line 29, it is stated that the magnetic field cycling method described in Axelsson et al. includes the step of increasing the field strength in an adiabatic process. On page 15, lines 28-29 it is again stated that re-magnetization in the magnetic field cycling method described in Axelsson et al. is an adiabatic re-magnetization. Claim 1 and dependent claims 2-11 clearly state that in the magnetic field cycling method according to the present invention, the increase of the magnetic field is carried out as such that a non-adiabatic re-magnetization of the contrast agent is obtained.

Moreover, Applicant would further like to point out that – as described in the present application on page 3, lines 3 to 10, page 4, lines 15 to 16 and figures 5/6, – with the magnetic field cycling method claimed in claims 1-11, the degree of polarization of the MR

contrast agent can be further increased. Axelsson et al. fails to disclose, teach or suggest that such a further increase of polarization could be achieved by the use of a magnetic field cycling method wherein an increase of the magnetic field is carried out as such that a non-adiabatic re-magnetization of the contrast agent is obtained, as recited by claims 1-11.

Since Axelsson et al. fails to disclose, teach, or suggest an increase of the magnetic field which is carried out as such that a non-adiabatic re-magnetization of the contrast agent is obtained, Applicant respectfully submits that claims 1-11 are patentably distinct thereover. Reconsideration and withdrawal of the rejection are respectfully requested.

**Double Patenting – provisional obviousness-type double patenting rejection**

Claims 1-11 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3-6 of copending Application No. 10/526,240. This rejection is respectfully traversed.

Applicant respectfully disagrees with the Examiner's statement that the claims of the present application and the co-pending application US 10/526,238 are not patentably distinct. Both applications are related to increasing the polarization of a MR contrast agent produced by hydrogenation of a substrate compound with para-hydrogen enriched hydrogen by a magnetic field treatment. However, the way this magnetic field treatment is carried out during the exposing step is technically different; in brief: pulses in US 10/526,238 in contrary to a field cycling treatment with non-adiabatic re-magnetization in the present application. In view of this technical difference, Applicant respectfully submits that the claims are not obvious variants of one another.

In view of the amendments and remarks hereinabove, Applicant respectfully submits that the instant application, including claims 1-11, is in condition for allowance. Favorable action thereon is respectfully requested.

Appl. No. 10/526,240  
Amdt. Dated: February 10, 2009  
Reply to Office action of August 14, 2008

Any question with respect to foregoing may be directed to Applicant's undersigned counsel at the telephone number below.

Respectfully submitted,

/Robert F. Chisholm/  
Robert F. Chisholm  
Reg. No. 39,939  
Attorney for Applicants

GE Healthcare, Inc.  
101 Carnegie Center  
Princeton, NJ 08540  
Tel: (609) 514-6905  
Fax: (609) 514-6527

I:\IP\Response to Office Action\PS\PS0269 (02-10-09).doc